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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/654,201	09/01/2000	Gary J. Pond	4285-16408-CIP	6274

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EXAMINER

O CONNOR, CARY E

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 02/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/654,201

Applicant(s)

Pond

Examiner

Cary E. O'Connor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 18-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) //
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2-4

- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other

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DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites the limitation "said predetermined bend" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 4, 13 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Stropko (5,378,149). Stropko shows a surgical needle 14 comprising a needle 34 having one end encapsulated in a hub member 40 and including a coextensive bore and a hollow shaft portion. The distal end of the needle includes an arcuate longitudinal skived portion 38. The hub member is a LUER connector. As to

claim 4, see Figure 5. As to claims 10 and 11, the hub and needle may be made of metal which would inherently be autoclavable to at least a temperature 135°C.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stropko (5,378,149). Without a showing of criticality, the proportion of the height of the skived portion to the diameter of the bore would have been an obvious design choice to one of ordinary skill in the art.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stropko (5,378,149) in view of Okamoto et al (4,979,900). Stropko does not disclose the angle of the bend in the needle. Okamoto shows an endodontic needle 4 which is bent and discloses that it may be bent at a 45° angle. It would have been obvious to one of ordinary skill in the art at the time the invention was made to bend the needle of Stropko to 45 degrees, in view of Okamoto, in order to provide easier insertion into the tooth root.

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Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stropko (5,378,149) in view of Magovern et al (4,142,531). Magovern teaches the use of a corrosion resistant coating, specifically a parylene polymer, on a catheter. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the needle of Stropko with a coating of a parylene polymer, in view of Magovern, in order to electrically and chemically isolate the needle surface from its environment and prevent corrosion.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stropko (5,378,149) in view of Fan et al (5,295,978). Stropko does not teach a hydrophobic lubricating agent coating the shaft portion. Fan teaches a hydrophobic lubricating agent which may be applied to medical instrumentation to make them more slippery and less likely to damage tissue. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the needle of Stropko with a hydrophilic lubricating agent such as that taught by Fan, to prevent the needle from getting hung up on the walls of the root canals and damaging the walls.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stropko (5,378,149) in view of Fan et al (5,295,978) as applied to claim 8 above, and further in view of Magovern et al (4,142,531). Magovern teaches the use of a corrosion resistant coating, specifically a parylene polymer, on a catheter. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the needle of Stropko as modified by Fan with a coating of a parylene polymer, in view of

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Magovern, in order to electrically and chemically isolate the needle surface from its environment and prevent corrosion.

Claim 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stropko (5,378,149) in view of Buchanan (5,752,825). Buchanan shows endodontic shaping instruments which can be made of Nitinol. The Nitinol make the instruments flexible enough to traverse the root canals without breaking. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the needle of Stropko of Nitinol, in view of Buchanan, so that the needle can be inserted down into the root without breaking.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stropko (5,378,149) in view of Riitano (6,079,979). Riitano shows a dental needle assembly wherein the hub is angled, rather than the needle itself. It would have been obvious to one of ordinary skill in the art at the time the invention was made to place the bend in the hub of the needle of Stropko rather than in the needle, in view of Riitano, to allow for easier insertion of the tip into the canal.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stropko (5,378,149) in view of Akhavi (4,240,423). Stropko inherently discloses the method of fabricating a needle assembly except for the step of adhesively fixing the needle in the hub with an autoclavable adhesive. Akhavi teaches a method of fixing a needle to a hub using an autoclavable adhesive 3. It would have been obvious to one of ordinary skill in the art at the time the invention was made to attach the needle of Stropko to the

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hub using an autoclavable adhesive, in view of Akhavi, so that the needle assembly would not be destroyed during the sterilizing procedure.

Claims 18-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stropko (5,378,149) in view of Riitano (6,069,979). Stropko shows the claimed needle assembly except for the angle-adjustment sleeve. Riitano shows a needle assembly comprising a needle 170 fixed in an angle-adjustment sleeve 160 (see Figure 7). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the needle assembly of Stropko with an angle adjustment sleeve, as taught by Riitano, so that the needle may be made more flexible to enable it to adapt to the curvature of the canal (i.e. the adjustment of the angle is done by the sleeve thus allowing the needle to be more flexible).

Allowable Subject Matter

Claims 16 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cary E. O'Connor whose telephone number is 703-308-2701. The examiner can normally be reached on M-F 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Mancene can be reached on 703-308-2696. The fax phone numbers

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for the organization where this application or proceeding is assigned are 703-308-0758 for regular communications and 703-308-0758 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.



Cary E. O'Connor
Primary Examiner
Art Unit 3732

ceo
February 25, 2002